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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/963,674 | 09/27/2001 | Kenji Ohmori | 011020 | 8984 |
| 23850 | 7590 | 09/17/2004 | | |
| ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006 | | | | |
| | | | EXAMINER NAKARANI, DHIRAJLAL S | |
| | | | ART UNIT 1773 | PAPER NUMBER |

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,674

Applicant(s)

OHMORI ET AL.

Examiner

D. S. Nakarani

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/02/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10, 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,638,367 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method and amount of phosphoric acid used for treating rare-earth magnet powder in U.S. Patent 6,638,367 B2 is identical to the method and the amount of phosphoric acid used in the present invention (Page 10, lines 1-7 and Examples 1-6). Therefore the treated rare-earth magnet powder of U. S. Patent 6,638,367 B2 inherently has claimed uniformity of coating and coating thickness of the phosphate film. The U. S. Patent 6,638,367 B2 also claims claimed resin composition and a bonded magnet.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al (U.S. Patent 4,668,283) in view of Furuya et al (U.S. Patent 5,393,445).

Honda et al disclose rare earth magnetic powder treated with phosphoric acid to protect the magnetic powder from oxidation and deterioration (Abstract). Honda et al also disclose resin composition for a bonded magnet (abstract). Honda et al disclose that conventional phosphating or phosphate-picking solution as a lubricant thick layer on the surfaces of magnetic powder resulting low bulk density and rare earth plastic magnets obtained by using the low bulk density powder as a raw material were not fully satisfactory in their performances (see comparative Example 4 and col.2, lines 18-26). Thus Honda et al suggest thinner coating. However, Honda et al do not disclose claimed coating thickness.

Furuya et al teach rare earth bonded magnet and rare earth magnetic powder coating with a monomer or polymer of 2,2-bis(cyanatophenyl) propane in an amount not more than 2 wt % for preventing oxidation of the rare-earth magnetic powder (abstract). Furuya et al also disclose that coating the rare-earth magnetic powder higher than the 2 wt % of the above compound degrade the magnetic properties. However Furuya et al also do not disclose a claimed coating thickness.

The present disclosure treats rare earth magnetic powder with phosphoric acid using an amount 0.16 to 0.30 mole/kg of rare earth magnetic powder i.e. 1.312 to 2.46 wt % phosphoric acid based on weight of rare earth magnetic powder (Table 1).

The rare earth magnetic powders of Honda et al and of Furuya et al are same as disclosed in the present disclosure.

Therefore it would have been obvious to a person of ordinary skill in the art at the time of this invention made to utilize disclosure of Furuya et al in the invention of Honda et al to treat rare earth magnetic powder with phosphoric acid using an amount of not more than 2 wt % based on rare-earth magnetic powder. Thus treated rare earth magnetic powder inherently will have claimed coating thickness.

No claims are allowed.

5. Applicant's arguments with respect to claims 1-10, 13 and 14 have been considered but are moot in view of the new ground(s) of rejection.
6. Receipt of Information Disclosure Statement filed July 02, 2003 is acknowledged and has been made of record.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday - Friday from 7:00a.m to 5:30p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nakarani/tgd

September 15, 2004


D. S. NAKARANI
PRIMARY EXAMINER